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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/568,424	02/14/2006	Takashi Yoshimine	OMY-0056	9347

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WASHINGTON, DC 20036

EXAMINER

NGUYEN, THONG Q

ART UNIT	PAPER NUMBER
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2872

MAIL DATE	DELIVERY MODE
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06/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/568,424	YOSHIMINE, TAKASHI	
	Examiner	Art Unit	
	Thong Nguyen	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1 and 4-8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 March 2009 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment filed on 3/23/2009. It is noted that in the amendment, applicant has made changes to the abstract, the drawings, the specification and the claims.
2. Regarding to the specification, applicant has submitted a substitute specification with its marked-up copy showing the changes to the specification, and a statement that the substitute specification does not contain any new matter.
3. Regarding to the claims, applicant has amended claim 1 and 4-8 and canceled claim 2-3. There is not any claim being added. As a result of the changes to the claims, the pending claims are claims 1 and 4-16 in which claims 1 and 4-8 are examined in this Office action. Regarding to the claims 9-16 which have not been examined as being directed to a non-elected species applicant is invited to amend the claim 9 by adding the features recited in claims 10-11 so that all claims 9-16 are rejoined and allowed with claims 1 and 4-8. See the section of "Allowable Subject Matter" provided below.

Drawings

4. The replacement sheet contains figures 10A-B was received on 3/23/09. The replacement sheet is approved by the examiner. As a result of the changes to the drawings as provided in the amendment of 3/23/09 and the pre-amendment of 2/14/06, the application now contains six sheets of figures 1-6 and 12 as filed on 2/14/06, five replacement sheets contained figures 7A-B, 8A-C, 9A-C, 11A-C and 13 as filed with the

Pre-amendment of 2/14/06, and one replacement sheet contained figures 10A-B as filed on 3/23/09.

5. The objections to the drawings as set forth in the previous Office action are overcome by the amendments to the drawings and the specification as provided in the amendment of 3/23/09.

Specification

6. The lengthy specification which was amended by the amendment of 3/23/09 has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

7. The substitute specification filed on 3/23/2009 has been entered.

8. The summary of the invention is objected to because it contains numerous details of the invention. Applicant should provide a brief technical description of the invention in the Summary and moves other detailed description to the section of "Detailed Description of the Invention".

Claim Objections

9. Claims 1 and 4-8 are objected to because of the following informalities.

Appropriate correction is required.

a) In claim 1: on line 10, the feature thereof "the optical axis of the first optical system" lacks a proper antecedent basis. Should the term "the" appeared before the term "optical" be changed to --an--?

Applicant should note that the mentioned objection is raised in the previous Office action, see element 12(b). While applicant has stated that the mentioned feature is changed in the claim, see amendment, page 11; however, applicant has not amended the claim to overcome the objection.

b) The remaining claims are dependent upon the objected base claim and thus inherit the deficiency thereof.

Claim Rejections - 35 USC § 112

10. The rejections of claims 3-6 and 8 under 35 U.S.C. 112, second paragraph, as set forth in the previous office action are overcome by the amendments to the claims as provided in the amendment of 3/23/09.

Allowable Subject Matter

11. Claims 1 and 4-8 would be allowable if claim 1 is rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

12. The following is a statement of reasons for the indication of allowable subject matter:

The objective lens as recited in the independent claim 1 is patentable with respect to the prior art, in particular, the Japanese reference No. 10-31164 and the Germany reference No. 34 09 657 by the limitations related to the shield mechanism for varying an incident area of a dark field illumination. It is noted that the use of a shield mechanism for such a purpose is disclosed in each of the mentioned reference; however, the cited art does not disclose that the shield

mechanism having the following features: a) a plurality of shield plates layered in the direction of an optical axis of an optical system; b) the shield plates are opened/closed by rotation about the optical axis; c) each of the shield plate includes a first fit portion having a ring shape and fits the cylindrical surface of a hold member and a second fit portion that fit an adjacent shield plate and causes the shield plates to be rotated together as claimed.

It is noted that the device of claim 1 is patentable for the structure of the shield mechanism as mentioned above, the structure of the shield mechanism is also claimed in the non-elected claims 10-11 of the non-elected species (II). Thus, it is suggested that the claim 9 should be amended to incorporate the features recited in claims 10-11 so that all claims 9-16 are rejoined and allowed.

Applicant should note that if applicant does not amend the claims as suggested above and select to cancel the claims 8-16 so that the subject matter of claims 8-16 is claimed in a Division application then such subject matter of the Division application will be subjected to a double patenting rejection based on the subject matter recited in claims 1 and 4-8 of the present application.

Conclusion

13. This application is in condition for allowance except for the following formal matters:

First, the objections to the summary of the invention and the objection to claim 1;

Second, the suggestion to incorporate the features recited in claims 10-11 into claim 9 so that claims 9-16 will be rejoined and allowed with the claims 1 and 4-8..

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thong Nguyen/

Primary Examiner, Art Unit 2872

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